

REMARKS/ARGUMENTS

Claims 1-24 are pending.

Claims 1-2, 13 and 14 are rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,515,695 to Sato et al. ("Sato") in view of JP 07-115633 to Nishimura ("Nishimura").

Claims 8-9 and 20-21 are rejected under 35 U.S.C. §102(b) as being anticipated by Nishimura.

Claims 3-7 and 15-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Nishimura and further in view of JP 11-234641 to Saiki ("Saiki").

Claims 10-11 and 22-23 are rejected under 35 U.S.C. § 103 as being unpatentable over Nishimura in view of Saiki.

Claims 12 and 24 are rejected under 35 U.S.C. § 103 as being unpatentable over Nishimura in view of JP 2003032727A to Nakajima ("Nakajima").

Reconsideration of the application in light of the remarks below is respectfully requested.

All of independent claims 1, 8, 13 and 20 claim a reply method in a videophone terminal related to a telephone number of a communicating terminal, where the reply method includes a reply using any one of a camera image, a still image or a substitute image. The Office Action agrees that such limitations are not shown in the Sato reference and points to Nishimura. However, even a combination of Sato and Nishimura does not show a reply method related to a telephone number where the reply method includes one of the above images. In Sato connection procedures are established based on a telephone call but no images are sent related to a telephone number. See, for example, Sato Abstract. In Nishimura, images may be sent to a communicating terminal, however, there is no indication that such images are based on the telephone number of the communicating terminal as is claimed. As such, even a combination of the Nishimura and Sato references will not yield the above reference limitations because even a combination of the two references does not yield a reply method related to a telephone number and including images as is claimed. Moreover, the Saiki reference and the Nakajima reference are not cited to show, and do not appear to show, the above referenced limitations. As a consequence, it is assumed that independent claims 1, 8, 13 and 20 are patentable even over a combination of the cited art.

Moreover, there is no motivation shown in the cited art for combining Sato and

Nishimura as is required under MPEP § 706.02(j). The Examiner states on page 3 of the Office Action that the combination of Sato and Nishimura "would facilitate audio and video message appropriate for the caller as taught by Nishimura, thus facilitating sending appropriate message to the caller suitable for him." Office Action, page 3. Yet, there is no indication where in the prior art there is a motivation for actually making such a modification of either Sato or Nishimura. The Examiner appears to be simply stating a perceived benefit of the combination and not a motivation for actually making the combination. As such, a prima facie case of obviousness cannot be made.

Therefore, it is asserted in independent claims 1, 8, 13 and 20 are patentable over the art of record. Dependent claims 2-7, 9-12, 14-19 and 21-24 include the above referenced limitations of independent claims 1, 8, 13 and 20, respectively, and include additional recitations which, when combined with limitations of independent claims 1, 8, 13 and 20 are also not disclosed nor suggested in the art of record. It is asserted that these claims are patentable as well. Reconsideration of the rejection of claims 1-24 under 35 U.S.C. §§ 102 and 103 is respectfully requested in light of the remarks above.

It is asserted that the present communication places the application in a form for allowance or in a better position for appeal. Entry is earnestly solicited.

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Respectfully submitted,

Max Moskowitz
Name of applicant, assignee or
Registered Representative

Signature

April 18, 2006
Date of Signature

Max Moskowitz
Registration No.: 30,576
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700